Applicant : Roy Ben-Yoseph et al.   Attorney's Docket No.: 06975-498001 / Security 30
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REMARKS

Claims 1-193 are pending in the application, with claims 1, 33, 65, 97,129, and 161 being independent. Claim 193 is newly added. Claims 33 and 129 have been amended simply to correct an antecedent basis error. Independent claims 97,129, and 161 have also been amended to address the 35 USC 101 rejection. Reconsideration of Applicant's claims is respectfully requested in light of the following remarks.

Claims 1-192 are provisionally rejected based on nonstatutory obviousness-type double patenting over claims 1-63 of pending Application No. 10/747,263, claims 1-55 of pending Application 10/747,676, and claims 1-4, 6-23 and 25-39 of pending Application 10/747,678. Applicants ask that this rejection be held in abeyance until allowable subject matter is agreed upon so that Applicants can evaluate the propriety of this rejection with respect to allowed subject matter.

Further, Applicants note that the Office Action states that the claims of the '263, '676, and '678 applications encompass the same metes, bounds, and limitations as those in the instant application. However, the claims in those applications contain different limitations than those in the claims of the instant application, and therefore do not encompass the exact same subject matter, even though there may or may not be some overlap. It is the language of the claims that define their scope.

Claims 97-192 are rejected under 35 USC. §101. Independent claims 97,129, and 161 have been amended to specify that the computer usable medium is tangible. Applicant submits that this overcomes the rejection and request that it be withdrawn.

Claims 1-192 are rejected under 35 USC. §102 as being anticipated by US. Patent No. 6,393,464 (Dieterman). Applicant respectfully requests that these rejections be withdrawn because Dieterman does not describe or suggest all of the limitations of independent claims 1, 33, 65, 97,129, 161 and 193.

For instance, with respect to claim 1, Dieterman does not describe or suggest inferring that a person is associated with the user based, at least in part, on inclusion of the person in <u>a</u> <u>contact list of a second person</u>, wherein the second person is not the user, and then adding the

inferred person to <u>the list of people associated with the user</u>, as recited in claim 1. There are two lists recited: (i) a contact list of a second person who is not the user; and (ii) the list of people associated with the user. A person is inferred to be associated with the user based on his or her inclusion on one list, and then added to the second list. Dieterman describes, at most, a single list and therefore does not describe or suggest this feature of independent claim 1.

Specifically, Dieterman describes a parental control system where emails to and from a child's account are selectively delivered based on "an allowed list." *See, e.g., Abstract.* Typically, the allowed list is created by the parent/account administrator manually adding email addresses to the allowed list. *See Dieterman, col. 3, line 49 – col. 4, line 5, FIG. 2.* Dieterman also describes that an e-mail address can be added to the allowed list when the administrator approves a message from the sender. See Col. 6, lines 5-10. In both cases, Dieterman only describes one list, the allowed list created by the parent/administrator. The allowed list is created with no reference to any other list. Consequently, the e-mail address is not added to the list based on inclusion of the e-mail address in a contact list of a second person. Dieterman, therefore, does not describe or suggest inferring that a person is associated with the user based, at least in part, on inclusion of the person in a contact list of a second person, wherein the second person is not the user, and then adding the inferred person to the list of people associated with the user, as recited in claim 1.

Similarly, independent claim 33 recites "inferring that a person is associated with the user based, at least in part, on a membership of the first person in a contact list that is associated with another person, wherein the contact list is not configured for direct access by the user; adding the inferred person to the list of people associated with the user." Claim 65 recites" inferring that a person is associated with the user based, at least in part, on the characteristics of one or more contact lists associated with other users, wherein the contact lists associated with the other users include communication identifiers selected by the other users; adding the inferred person to the list of people associated with the user." Claim 97 recites "infer that a person is associated with the user based, at least in part, on inclusion of the person in a contact list of a second person, wherein the second person is not the user; add the inferred person to the list of people associated

with the user." Claim 129 recites "inferring that a person is associated with the user based, at least in part, on a membership of the first person in a contact list that is associated with another person, wherein the contact list is not configured for direct access by the user; adding the inferred person to the list of people associated with the user." Claim 161 recites "inferring that a person is associated with the user based, at least in part, on the characteristics of one or more contact lists associated with other users, wherein the contact lists associated with the other users include communication identifiers selected by the other users; adding the inferred person to the list of people associated with the user." Applicant submits that Dieterman do not describe or suggest these features of claims 33, 65, 97,129, and 161 at least for the reason described with respect to claim 1.

Additionally, the newly added independent claim 193 also requires two lists: "a first list of online identities associated with an online identity of a first user" and "a second list of online identities associated with an online identity of a second user other than the first user." Applicant submits that Dieterman also fails to describe or suggest these features of claim 193 at least for the reason described with respect to claim 1.

Therefore, Applicant submits that independent claims 1, 33, 65, 97,129, 161 and 193 and those claims that depend from them, are allowable over Dieterman for at least the reasons given above.

Conclusion

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, objection, issue, or comment, including the Office Action's characterizations of the art, does not signify agreement with or concession of that rejection, issue, or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment or cancellation of any claim does not necessarily signify concession of unpatentability of the claim

prior to its amendment or cancellation. Applicant reserves the right to prosecute the rejected claims in further prosecution of this or related applications.

The fee in the amount of $260 in payment of the excess claim fees is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account authorization. Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

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